REMARKS

In the Office Action dated November 4, 2005, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Hoyt et al. ("Hoyt") (U.S. Patent No. 6,067,531) in view of Manzi et al. ("Manzi") (U.S. Patent No. 6,298,333) and Longfield (U.S. Patent No. 5,724,523).

Applicant wishes to thank the Examiner for speaking with Applicant's representatives during an interview on February 1, 2006. The remarks presented below are consistent with the topics discussed during the interview.

Applicant has added independent claim 49 in this Reply. Claims 1-7 and 9-49 are now pending in this application.

Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverses the Section 103(a) rejection of claims 1-23 and 48 based on Hoyt, Manzi, and Longfield because a case for *prima facie* obviousness has not been established. As M.P.E.P. § 2142 states, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143 (8th ed. 2005) Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2005). In this case, the requirements for *prima facie* obviousness are lacking, as discussed below.

Independent claim 1 recites a combination of steps including, *inter alia*, "selecting a paying party from a group of paying parties, to pay the tax amount, as a function of the set of tax rules." Neither Hoyt, Manzi, or Longfield, or any combination thereof, discloses at least these claim features. Indeed, the Examiner admits that the combination of Hoyt and Manzi fails to disclose the feature of selecting a paying party from a group of paying parties to pay the tax amount as a function of the set of tax rules. See Office Action at page 3. In attempt to remedy this deficiency of Hoyt and Manzi, the Examiner has combined the disclosure in Longfield pertaining to selecting between parties as to who will pay on another's behalf with the teachings of Hoyt and Manzi. See id. (citing Longfield, column 3, lines 41-50). Applicant respectfully submits that the combination of Longfield with Hoyt and Manzi does not render claim 1 obvious.

Longfield discloses a method for a tax filer to obtain a refund loan payment from an authorized credit/financial institution. See Longfield, Abstract and column 3, lines 40-50. The refund loan is processed by determining whether or not payment is to be made through an authorized preparer or directly by the authorized financial institution. See Longfield, column 3, lines 40-50. However Longfield does not disclose that the authorized preparer of the authorized financial institution are selected to pay a tax amount, as required by claim 1. (Emphasis added). Instead, Longfield discloses that the tax preparer or the financial institution are selected to pay a refund loan. See Longfield, column 3, lines 33-45. (Emphasis added).

Furthermore, Longfield does not disclose that the selection of a party to pay the refund loan is made as a "function of the set of tax rules," as required by claim 1. Indeed, the disclosure of a selection of a paying party to pay a tax refund loan that may

be based on a given set of rules which are established in advance does not constitute "selecting a paying party from a group of paying parties, to pay the *tax amount, as a function of the set of tax rules*," as required by claim 1. The Examiner appears to be interpreting "the set of tax rules" as any rule that designates one party to pay on behalf of another. However, this interpretation vitiates the modifier "tax" in the term "tax rules." Therefore, contrary to the Examiner's apparent assertion, a rule that designates one party to pay a tax refund loan on behalf of the other does not constitute "selecting a paying party from a group of paying parties, to pay the *tax amount, as a function of the set of tax rules*," as required by claim 1.

Furthermore, determinations of obviousness must be supported by evidence on the record. See In re Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). The desire to combine or modify references must be proved with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. See In re Lee, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52). Additionally, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be "clear and particular." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Examiner has not shown by "clear and particular" evidence that a skilled artisan considering Longfield, and not having the benefit of Applicant's disclosure, would have modified the combination of Hoyt and Manzi in a manner

resulting in the method defined by claim 1. The Office Action provides no reasoning or evidence to show that one having ordinary skill in the art considering the combination of Hoyt and Manzi would consider combining the disclosure in Longfield with the combination of Hoyt and Manzi. The Examiner's assertion that the motivation to combine being "that the person most responsible for the paying should be the one to pay" is a conclusion that is not evidenced in either Hoyt, Manzi, or Longfield.

As M.P.E.P. § 2143.01 makes clear, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (citations omitted). In this case, the Examiner has not shown that either of Hoyt, Manzi, or Longfield "suggests the desirability" of "selecting a paying party from a group of paying parties, to pay the tax amount, as a function of the set of tax rules, " (emphasis added), as required by claim 1. Applicant respectfully submits that the Examiner is impermissibly using teachings of the present application in hindsight to suggest that claim limitations of the present application would be obvious to one having ordinary skill in the art in view of Longfield. For example, the Examiner has not shown evidence in the prior art of a motivation to combine the paying concept taught in Longfield with Hoyt and Manzi without any of the attendant context of the concept taught in Longfield. Such use of impermissible hindsight in making a *prima facie* case of obviousness is prohibited. See M.P.E.P. § 2142.

For at least these reasons, prima facie obviousness has not been established with respect to claim 1. The Examiner did not specifically address independent claim 23. Nevertheless, claim 23, although different in scope, includes elements similar to the

elements of claim 1. Therefore, independent claim 23 is allowable for at least the reasons discussed above. Dependent claims 2-7, 9-22, and 48 ultimately depend on claim 1 and, therefore, are allowable for at least the reasons discussed above and in view of their additional recitations of novelty.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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